

## REMARKS

This is intended as a full and complete response to the Final Office Action dated March 13, 2009, having a shortened statutory period for response set to expire on June 13, 2009. Please reconsider the claims pending in the application for reasons discussed below.

Claims 83-115 and 117-120 remain pending in the application and are shown above. Claims 83-115 and 117-120 are rejected by the Examiner. Reconsideration of the rejected claims is requested for reasons presented below.

### *Interview Summary*

A telephonic interview was conducted on May 8, 2009 between the Examiner, Walt Grollitsch and Aaron Perkins. The parties discussed the cited reference to *Amin, et al.* (U.S. 6,536,528) ("Amin"). Claim 83 was also discussed. The rejection under § 112 was also discussed.

The arguments and amendments herein are presented in accordance with the substance of the interview to place the application in better condition for allowance.

### *Claim Rejections Under 35 U.S.C. § 112*

Claims 83-97 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner states with respect to claim 83 that "it appears *full diversion* (no production fluid is continuing after the first tap along pipeline 20) is being claimed." Based on this observation, the Examiner has rejected claim 83 and its dependents as not enabled because "[t]he specification and figures fail to show how this is possible." Applicant respectfully traverses.

The test of enablement is framed by the question: "is the experimentation needed to practice the invention undue or unreasonable?" MPEP § 2164.01 (citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916). In other words, "[t]he test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *Id.* (citing *United States v. Telecommunications, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988).

The present application enables full diversion as well as partial diversion. For example, Figure 2 indicates that fluid 45 is diverted from pipeline 20 into tubular 11. If problem area 70 is a total blockage, then fluid 45 will be fully diverted into tubular 11. If problem area 70 is only partial blockage, the fluid 45 will be at least partially diverted into tubular 11. See ¶ [0045] (noting that problem area 70 may include, *inter alia*, partial or total blockage). No undue experimentation would be required to practice the invention. Therefore, Applicant respectfully submits that the full breadth of claim 83, and its dependents, is enabled.

Accordingly, Applicant respectfully requests withdrawal of the § 112 enablement rejection.

#### ***Claim Rejections Under 35 U.S.C. § 103***

Claims 83-86, 88-95, 97, 115, and 117 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Amin* in view of *Hicks*.

Applicant respectfully traverses the rejection as it applies to the amended claims. The cited references do not teach or suggest diverting wellbore fluid to a storage tank at a secondary location, as set forth in independent claims 83 and 115. In fact, the cited references actually teach away from diverting wellbore fluid to a storage tank at a secondary location.

For example, *Amin* does not teach or suggest that riser 22 can be used to divert wellbore fluid from the pipeline 16 to the floating vessel 20. Rather, *Amin* teaches that the fluid flow in product flow line 16 to a host platform 100 should be kept separate from the floating platform 20 and umbilical 22. See col. 5, lines 12-15 ("By splitting the control and production requirement between a host facility and a local platform, significant advantages and cost savings can be realized."); claim 1 (col. 5, lines 20-28) ("at least one flowline connecting the deep well to said host facility without passing through said floating platform," "a control umbilical connecting said platform to the deep well without passing through an intermediate storage facility"). Thus, *Amin* teaches away from diverting wellbore fluid to a storage tank at a secondary location.

Furthermore, these features are not taught or suggested in *Hicks*. *Hicks* teaches using two taps around a damaged area in the pipeline to permit installation of a bypass.

Col. 5, lines 31-35. Thus, *Hicks* teaches away from the presently claimed features by suggesting a *bypass* pipeline—as opposed to diversion to a storage tank at a secondary location—to allow repair to a damaged section of pipeline. *Hicks*, col. 5, lines 30-34.

As the foregoing illustrates, the combination of *Amin* and *Hicks* fails to teach or suggest all the limitations of claims 83 and 115. This failure precludes the combination of *Amin* and *Hicks* from rendering claims 83 and 115 obvious. For these reasons, Applicant submits that claims 83 and 115 are in condition for allowance and respectfully requests withdrawal of the § 103(a) rejection. Additionally, the claims that depend from claims 83 and 115 are allowable for at least the same reasons as claims 83 and 115.

Claims 98-113 and 118-120 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Amin* alone. Applicant respectfully traverses the rejection as it applies to the amended claims. As set forth above, *Amin* teaches that the fluid flow in product flow line 16 to a host platform 100 should be kept separate from the floating platform 20 and umbilical 22. Thus, *Amin* teaches away from diverting wellbore fluid to a secondary location comprising a storage tank on a floating vessel, as set forth in amended claim 98. Similarly, *Amin* teaches away from diverting wellbore fluid through a first communication pathway to a secondary storage tank at an offshore location, as set forth in amended claim 108. *Amin* also teaches away from intervening in an existing pipeline while wellbore fluid flows through a diversionary flow path between the existing pipeline and a secondary storage unit on a floating vessel, as set forth in amended claim 118.

As the foregoing illustrates, *Amin* fails to teach or suggest all the limitations of claims 98, 108 and 118. This failure precludes *Amin* from rendering claims 98, 108 and 118 obvious. For these reasons, Applicant submits that claims 98, 108 and 118 are in condition for allowance and respectfully requests withdrawal of the § 103(a) rejection. Additionally, the claims that depend from claims 98, 108 and 118 are allowable for at least the same reasons as claims 98, 108 and 118.

Claims 87, 96, and 114 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Amin* and/or *Hicks*, as applied to claims 83 and 108, and further in

view of *Hansen*, (EP 1184537) ("*Hansen*"). Applicant respectfully traverses the rejection as it applies to the amended claims. *Hansen*, which teaches a method for stimulating a well with acid, does not supply the base claim elements missing in *Amin* and *Hicks*.

As the foregoing illustrates, the combination of *Amin*, *Hicks* and *Hansen* fails to teach or suggest all the limitations of claim 83 (from which claims 87 and 96 depend) and claim 108 (from which claim 114 depends). This failure precludes the combination of *Amin*, *Hicks* and *Hansen* from rendering claims 83 and 108 obvious. For these reasons, Applicant submits that the claims 87, 96 and 114 are allowable for at least the same reasons as base claims 83 and 108 and respectfully requests withdrawal of the § 103(a) rejection.

***Conclusion***

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

Having addressed all issues set out in the Final Office Action, Applicant respectfully submits that all pending claims are in condition for allowance. Therefore, Applicant respectfully solicits withdrawal of the rejections and allowance of all claims.

Respectfully submitted,

William B. Patterson

William B. Patterson  
Registration No. 34,102  
PATTERSON & SHERIDAN, L.L.P.  
3040 Post Oak Blvd. Suite 1500  
Houston, TX 77056  
Telephone: (713) 623-4844  
Facsimile: (713) 623-4846  
Attorney for Applicant(s)